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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,549	02/12/2004	Giuseppe Di Sante	163-347.1	5748

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EXAMINER

BROWN, JAYME L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,549

Applicant(s)

DI SANTE ET AL.

Examiner

Jayme L. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 17 and 21-34, drawn to a method for providing a car interior with lining and fitting elements, classified in class 296.
  - II. Claim 20, drawn to a process for the processing of the multilayer product, classified in class 156.
2. The inventions are distinct, each from the other because of the following reasons:

The method of making the multilayer product (Group II) and the method of using the multilayer product (Group I) are unrelated inventions requiring limitations independent of one another.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. James Costigan on 7/11/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 17 and 21-34. Affirmation of this election must be made by applicant in replying to this Office action. Claim 20 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

6. The drawings are objected to because of the need for clarification of the word "vlies". This doesn't appear to be an English word for a term in the headliner art. Vlies is the German word for fleece. Applicant is asked to clarify if this is what is meant by the word "viles" and correct it accordingly (change "vlies" to - - fleece- -) in Figures 1-3.

**Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.** Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The disclosure is objected to because of the following informalities:

On page 6, line 2, there needs to be a clarification of the term "vlies". This doesn't appear to be an English word for a term in the headliner art. Vlies is the German word for fleece. Applicant is asked to clarify if this is what is meant by the word "viles" and correct it accordingly (change "vlies" to - - fleece- -) everywhere the term appears in the Specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 17 and 21-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "the central layer (B) (A) (B)" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Also regarding claim 17, it is also confusing as to what the structure is and should look like, especially the part about the central layer. It is recommended that the claim be rewritten as such:

A method for providing a car interior with lining and fitting elements, said method comprising installing in said car interior a multilayer product, wherein the multilayer product comprises:

a first element wherein the first element consists of:

a layer of spongy, semi-rigid polymer (A) impregnated on one or both sides with polyurethane resin (B), and  
a layer of glass fibre, natural fibre, or a combination of glass fibre and natural fibre (C) on either side of polymer (A) impregnated with resin (B);

a second element, coupled to the first element, wherein the second element comprises:

a layer of spongy, semi-rigid polymer (A) impregnated on one or both sides with polyurethane resin (B); and  
an additional layer of glass fibre, natural fibre, or a combination of glass fibre and natural fiber (C) coupled to the second element.

Regarding claims 21-34, "The process according to claim 17" should be changed to - - The method according to claim 17 - -.

Regarding claim 21, " a (B) (A) (B) (C) (B) (A) (B) structure" should be changed to - - a (C) (B) (A) (B) (C) (B) (A) (B) (C) structure - - so that it is the same structure as in claim 17.

Regarding claim 28, the term "vlies" in line 3 needs to be clarified. Vlies doesn't appear to be an English word for a term in the headliner art. Vlies is the German word for fleece. Applicant is asked to clarify if this is what is meant by the word "viles" and correct it accordingly (change "vlies" to - - fleece- -).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Satterfield et al. (U.S. Patent 5,007,976) is directed toward headliners for mounting in the passenger compartment of a vehicle and a method for making them. The headliners are made from a plurality of layers of materials included foamed polyurethane, fiber glass, scrim, remay, and decorative fabric. These layers are bonded together under heat and pressure, which cures the polyurethane adhesive that some of the layers are impregnated with (Abstract; Figure 2; Column 4, line 36 – Column 5, line 25).

Doerer et al. (U.S. Patent 5,089,328) is directed toward automotive liner panels and a method for making these panels. The panels are made of layers of reinforcing fibers, scrim, foam, adhesive film, and a cover sheet. The layers are bonded together

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under heat and pressure (Figures 2 and 3; Column 2, lines 3-11; Column 2, line 65 – Column 3, line 20).

Stevens et al. (U.S. Patent 5,976,646) is directed toward vehicle trim panels that include layers of natural fiber mats (abaca, sisal, flax) instead of glass fiber mats, which can cause skin irritation. The panels also include layers of scrim, foam, adhesive, and a fabric decorative layer (Figure 2; Abstract; Column 2, lines 22-61).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jayme L. Brown** whose telephone number is **571-272-8386**. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Jayme L. Brown*  
Jayme L. Brown

*John T. Haran*  
**JOHN T. HARAN**  
**PRIMARY EXAMINER**